

Amdt. Dated December 22, 2004

Reply to Non-Final Office Action of June 28, 2004

REMARKS

Claims 104-112 and 121-126 are pending in the application. The current Office action rejected claims 104, 108, 111, 112, and 121-126 under 35 U.S.C. § 112 second paragraph and claims 104-112 and 121-126 as being unpatentable under 35 U.S.C. § 103(a) over Fredlund et al. (“Fredlund”) (U.S. Patent No. 5,666,215) in view of Morris et al. (“Morris”) (U.S. Patent No. 5,153,936). The applicants respond as follows.

SECTION 112 REJECTIONS

The Office action on page 2 alleges that claims 104, 108, 111, 112, 121, 122, 123, 125 and 126 recite the limitation digital image(s) without sufficient antecedent basis. We do not agree with the examiner’s allegations. The claims as stated fully comply with the requirements of 35 U.S.C. § 112 second paragraph, in that the claims particularly point out and distinctly claim the subject matter which the applicants regard as their invention. However, several modifications, noted below, have been made in the interest of expediting a grant of allowance for these claims.

With respect to claim 104, the applicants contend that the references to “high resolution digital images” and “each digital image” comply with the statutory requirements of 35 U.S.C. § 112 second paragraph with regard to the subject matter claimed, but in the interest of expediting prosecution, claim 104 has been amended to address the examiner’s concern. Specifically, the claim has been amended to recite “high resolution digital images” throughout.

Regarding claims 108 and 122, the applicants are not able to find a basis for the examiner’s allegation that a similar antecedent basis problem exists relating to “digital image” and “digital images.” The applicants respectfully request clarification.

The examiner indicated some confusion on pages 2 and 3 of the Office action over the term “the subset” in claims 108, 112, 122 and 124. In each claim, the term subset is introduced using the indefinite article “a,” for example, “a subset of digital images.” Each subsequent use of the term subset uses the definite article, i.e., “the subset” for referring to the element properly introduced earlier. This usage complies with the statutory requirements of 35 U.S.C. § 112 second paragraph, and the applicants request the rejection be withdrawn.

It should be clear that the “subset of digital images” refers to digital images stored in the storage device and developed by the searching engine.

Claim 111 recited “each of a plurality of digital images” and later referred to “at least one of the digital images.” This language complies with the statutory requirements of 35 U.S.C. § 112 second paragraph. However, in the interest of expediting prosecution, the claim has been broadened to recite “digital image” throughout the claim. Consistent with Federal Circuit precedent, a term introduced with the indefinite article “a” encompasses both the singular and plural.

Claim 112 recites “digital images” as well as a first and second “digital image provider.” The applicants respectfully request clarification of the alleged antecedent basis problem.

In the interest of expediting prosecution and quick resolution of the examiner’s rejections, the following changes have been made with respect to singular/plural versions of elements. Claim 121 now recites “high resolution digital images” with one specific reference to “a high resolution digital image.” Claims 123 and 126 have been amended to recite “a first plurality of digital images” when referring to digital images provided by a first image provider. Claim 121 also now recites “a corresponding low resolution copy” which should be construed to include both singular and plural. Thus, more than one corresponding low resolution copy can be developed from a high resolution digital image. Claim 125 has been amended and now recites both “high resolution digital images” and “a high resolution digital image.” Applicants believe that claims 121, 123, 125, and 126 comply with the statutory requirements of 35 U.S.C. § 112 and the rejection should be withdrawn.

The examiner alleges on page 3 of the Office action that claims 104, 121 and 125 are vague, confusing and unclear. The applicants believe that claims 104, 121 and 125 fully meet the requirements of 35 U.S.C. § 112 second paragraph, and respectfully traverse this rejection. If the above amendments related to other alleged § 112 issues do not address the examiner’s concerns, the applicants request more specific details regarding the rejections.

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The examiner asks on page 3 of the Office action regarding claim 121 whether “applicants mean ‘an authorized user identified by the first image provider...?’”. The applicants respectfully state that the intended meaning is as recited, that is, “authorized users identified by the first image provider.” The examiner’s proposed meaning could be construed as incorrectly limiting the ability of the first image provider to identify only a single authorized user.

For at least the reasons stated above, the applicants believe that claims 104, 108, 111, 112, 121, 122, 123, 125 and 126 meet the requirements of 35 U.S.C. § 112 and that the rejections should be withdrawn.

CLAIMS 104-112 AND 121-126 MEET THE REQUIREMENTS OF SECTION 103(a)

The Office action states that claims 104-112 and 121-126 are not in compliance with 35 U.S.C. § 103(a) because, it is alleged, these claims recite inventions that are unpatentable over the combination of Fredlund in view of Morris. Specifically, the system in accordance with the current disclosure and as recited in the pending claims is a sharing system, in that an image provider may identify an authorized user in addition to the image provider capable of accessing digital images supplied by the image provider. Neither Fredlund nor Morris disclose such a system. Fredlund discloses a system where the only user identified to have the claimed access is the image provider and there is no capability to identify authorized users other than the image provider. In short, Fredlund does not teach or suggest the capability to identify additional authorized users. Likewise, Morris does not disclose a sharing system in which the image provider may identify additional authorized users. Therefore, the applicants submit that the inventions set forth in these claims meet the requirements of § 103(a), respectfully traverse the rejections of the Office action and request reconsideration.

In applicants’ last response of April 12, 2004, the applicants argued that Fredlund did not teach or suggest that an authorized user accesses and uses the high resolution copy of the digital image. Upon further review of this issue, the applicants now agree that the examiner has correctly determined that Fredlund *does* teach “access” to the high resolution image in that it allows the user to make use of the high resolution image for

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subsequent printing (col. 8, lines 58-59). Moreover, the examiner's position concerning the disclosure of access to the high resolution image is consistent with positions taken by the assignee of the present application in litigation involving patents to which the present application claims priority, United States Patent Nos. 6,321,231 B1 and 6,332,146 B1.

Claims 104, and claims 105-107 dependent therefrom, are not rendered obvious by Fredlund and Morris. The examiner admits that Fredlund does not teach the claim limitation "means for notifying an authorized user identified by the first image provider that the authorized user has been authorized to download a low resolution copy corresponding to one of the high resolution digital images, wherein the notifying means transmits at least a portion of a pathname associated with the low resolution copy to the authorized user."

The examiner alleges that Morris discloses, at col. 1, line 63 - col. 2 lines 1-4, a means for notifying an authorized user identified by the first image provider that the authorized user has been authorized to download a low resolution copy of the high resolution digital image, wherein the notifying means transmits at least a portion of a pathname associated with the low resolution copy of the authorized user. The applicants respectfully disagree. Morris discloses a workstation coupled to a disk drive system for storing high and low resolution copies of a digital image. Morris does not disclose or suggest the claimed recitation of authorized users of any kind. Nor does Morris disclose or suggest any kind of notification. Thus, Morris clearly does not disclose or suggest notification to authorized users. It follows that Morris does not disclose or suggest that users are authorized for access to digital images, of either high or low resolution. Furthermore, Morris does not disclose or suggest pathnames associated with digital images. Moreover, even if Morris supplied the elements missing in Fredlund, there is no suggestion to combine the references. The examiner's stated motivation to combine, found on page 5, relies on elements that are in neither of the references, i.e. third party access, downloading messages with images, and electronic addresses (Internet URLs), suggesting perhaps a reliance on unacceptable hindsight.

In summary, the examiner admits that Fredlund does not teach a means for notifying an authorized user. Morris does not teach or suggest, as discussed above,

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authorized users, notification; or pathnames used in the notification. Nor is there a motivation to combine Fredlund and Morris. For at least these reasons, Fredlund and Morris do not teach all the limitations of claims 104, and the rejection under 35 U.S.C. § 103(a) should be withdrawn. As claim 104 is allowable, its dependent claims 105-107 are allowable as well.

The examiner on page 4 of the Office action rejects claim 121 for the same reasons as claim 104, and on page 9 of the Office action rejects claim 125 for the same reasons as claim 104. Claims 121 and 125 do not recite the same limitations used in the rejection of claim 104. Therefore, the rejection of claim 104 should not be applied to claims 121 and 125.

Regarding claims 108, 111, and 126 the examiner alleges that the addition of a mail server and router would have been obvious in view of Fredlund's modem and interactive cable TV network to provide mail services and to connect two or more networks. We respectfully disagree with this allegation, but the point is moot because Fredlund does not teach or suggest all of the limitations of the claims, as Fredlund does not teach a sharing system. Therefore, the claims are allowable.

Moreover, Fredlund does not teach, disclose or suggest all of the limitations in the claims because it does not teach, disclose or suggest adding e-mail servers. In fact, the only mention of mail of any kind is surface mail in the first-described embodiment of the system (col. 3, lines 37-42). Fredlund's frequent references to surface mail for relaying data and orders teach away from electronic notification as claimed. For example, col. 6, lines 50-63 describe placing a final order by dialing a dedicated telephone number or mailing a diskette with instructions.

The applicants remind the examiner that in order to establish a *prima facie* case of obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In order to establish a *prima facie* case of unpatentability, particular factual findings demonstrating the suggestion to combine or modify must be made. See, for example,

Ecolochem Inc. v. Southern California Edison, 56 U.S.P.Q.2d 1065 (Fed. Cir. 2000) and In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617-1618 (Fed. Cir. 1999), where the Court of Appeals for the Federal Circuit stated:

In addition to demonstrating the propriety of an obviousness analysis, particular factual findings regarding the suggestion, teaching, or motivation to combine or modify serve a number of important purposes, including: (1) clear explication of the position adopted by the Examiner and the Board; (2) identification of the factual disputes, if any, between the applicant and the Board; and (3) facilitation of review on appeal.

Indeed, the law is quite clear that an obviousness rejection must be based on facts, not conjecture. Thus, applicants assert the examiner has not carried the required burden to establish a *prima facie* case of obviousness because there is no teaching or suggestion in either Fredlund or Morris to provide a mail server and router. It would not be obvious to modify the missing mail server and router and the examiner has provided no references that teach or suggest that such a modification would be possible, let alone beneficial. Therefore, a *prima facie* case of obviousness has not been established.

For at least these reasons, the rejection of claim 108, 111, and 126 and claims 109 and 110, depending from claim 108, should be withdrawn.

The Office action rejected claims 112 , 122, 123, and 124 as being obvious in view of Fredlund and Morris. The applicants respectfully traverse. As provided by the MPEP at 2144.03(C) the applicants request documentary evidence of the examiner's allegation that the following would have been obvious: "a job order developer responsive to inputs received from the first user for developing a job order that includes at least one high resolution copy of a digital image contained in the subset and identified by the first user for discriminating between users communicating with the system to control user access to the digital images provided by the first digital image provider, wherein the digital images provided by the first digital image provider are transparent to all users except users identified by the first digital image provider."

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Further, since neither Fredlund or Morris teach or suggest email notification or granting access to third parties, claims 112, 122, 123, and 124 are patentable and the rejection should be withdrawn.

In view of the foregoing, all of the claims are allowable over the cited references, and passage to allowance is respectfully requested. The amendments to the claims are made for clarification of antecedent basis or for broadening their scope. None of the claims have been narrowed for reasons related to patentability.

The Examiner is respectfully requested to pass this application to issue. If the examiner wishes to discuss any aspect of this response or the case in general, she is urged to contact the applicants' undersigned attorney. Should any additional fees be required, the Commissioner is authorized to charge or debit Deposit Account No. 13-2855.

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Respectfully submitted,

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